

Remarks

Applicants respectfully request reconsideration of the present U.S. Patent application as amended herein. Claims 1, 3-5, 14, 17, 22 and 28 have been amended. Claim 2 has previously been canceled. Thus, claims 1 and 3-45 are pending.

Claim Rejections – 35 U.S.C. § 112, Second Paragraph

Claims 14-16 have been rejected as failing to particularly point out and distinctly claim the subject matter of the invention. Specifically, a limitation of claim 14 lacked antecedent basis. Claims 15 and 16 depend from claim 14. Claim 14 has been amended to provide proper antecedent basis. Accordingly, Applicants request that the rejection of claims 14-16 under 35 U.S.C. § 112, Second Paragraph be withdrawn.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 1, 4, 14, 17, 22, 28 and 37-45 were rejected as being unpatentable over U.S. Patent No. 5,848,413 issued to Wolff, et al. (*Wolff*) in view of U.S. Patent No. 5,978,477 issued to Hull, et al. (*Hull*) and further in view of U.S. Patent No. 6,584,508 issued to Epstein, et al. (*Epstein*) and further in view of U.S. Patent No. 6,742,116 issued to Matsui (*Matsui*). Claim 4 has been amended to depend from claim 3, which was indicated as allowable. For at least the reasons set forth below, Applicants submit that claims 1, 14, 17, 22, 28 and 37-45 are not rendered obvious by *Wolff*, *Hull*, *Epstein* and *Matsui*.

Claim 1 recites:

a multifunction machine to supply multiple electronic documents that have been saved in the absence of an explicit command by a user to save the electronic documents and in response to another user specified function associated with the electronic documents;

a filter coupled with the multifunction machine to transform one or more of the electronic documents to meet predetermined content-based standards if the one or more electronic documents do not meet the standards for publication; and

a server coupled to the filter and to the multifunction machine, the server having memory to store the multiple electronic documents, the server to select and to publish a subset of electronic documents by selectively transmitting a document identifier and authorization information to one or more recipients, the document identifier and the authorization information to enable the one or more recipients to access one or more of the subset of electronic documents, the server having a module to allow customized utilities for published electronic documents.

Thus, Applicants claim a server that selects a subset of documents that have been captured by the multifunction machine and transformed by the filter if the captured documents do not meet predetermined standards. The selected documents are published by selectively transmitting a document identifier and authorization information to recipients. The server also may provide a module to allow customized utilities for the published documents.

Claim 14 similarly recites publishing a subset of captured electronic documents that have been transformed if the captured documents do not meet predetermined standards. Claim 17 similarly recites a server allowing access to a selected subset of captured electronic documents that have been transformed if the captured documents do not meet predetermined standards. Claim 22 is a means-plus-function claim that recites means for allowing access to a selected subset of captured electronic documents that have been transformed if the captured documents do not meet predetermined standards. Claim 28 is an article of manufacture claim that recites allowing access to a selected subset of

captured electronic documents that have been transformed if the captured documents to not meet predetermined standards.

As a preliminary matter, Applicants note that the purposes of the authorization information as disclosed by *Matsui* is different that the claimed use of authorization information. *Matsui* is directed to a chat client that allows multiple users to engage in a text-based “conversation.” See Figs. 2 and 3. *Matsui* does not relate to or even suggest use with electronic documents published in the manner as claimed. Therefore, it would not have been obvious to combine *Matsui* with the other cited references.

The section of *Wolff* cited in the Office Action discloses a gateway that receives a fax document and transforms the fax document to a hypertext document. See col. 7, lines 29-30 and 40-49. The documents are stored and identifiers are provided. See col. 7, lines 58-60. However, *Wolff* does not teach or suggest sending authorization information to one or more recipients. *Hull* is cited to teach storing documents without user intervention. See col. 6, lines 49-51. Thus, *Hull* discloses archival of documents. However, *Hull* does not disclose sending authorization information to one or more recipients.

Epstein is cited to teach content-based filtering. However, *Epstein* is not cited to teach, nor does *Epstein* teach, sending authorization information to one or more recipients. Because none of *Wolff*, *Hull* and *Epstein* teaches sending authorization information to one or more recipients in the manner recited in the claims, no combination of *Wolff*, *Hull*, *Epstein* and *Matsui* can render the claimed invention obvious.

None of the cited references are cited to teach the server having a module to allow customized utilities for published documents. As noted, for example, on page 15 of the detailed description may allow a publisher to provide utilities for use with the published documents. Because the format of a document may change during publication, the module may be useful on a server. This would not have been obvious at the time of filing because utilities are typically used and provided on the device on which the document was created, not on a publishing server. Therefore, no combination of *Wolff*, *Hull*, *Epstein* and *Matsui* can teach or suggest the invention as claimed.

Claims 29, 30 and 37-39 depend from claim 1. Claims 31 and 32 depend from claim 14. Claims 33, 34 and 40-42 depend from claim 17. Claims 35, 36 and 43-45 depend from claim 28. Because dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 31-45 are not rendered obvious by *Wolff*, *Hull*, *Bauer* and *Matsui* for at least the reasons set forth above.

Claims 8-13, 15, 16, 18, 23 and 27 were rejected as being unpatentable over *Wolff* in view of *Hull* and further in view of U.S. Patent No. 6,188,673 issued to Bauer, et al. (*Bauer*). Claims 8-13 depend from claim 1. Claims 15 and 16 depend from claim 14. Claim 18 depends from claim 17. Claims 23 and 27 depend from claim 22.

Bauer is cited to teach maintaining access logs on a server that provides access to electronic documents. Whether or not *Bauer* discloses access logs, nothing in *Bauer* teaches or suggests sending authorization information to recipients as discussed above. Therefore, *Bauer* does not cure the deficiencies of *Wolff* and *Hull*. Thus, no combination

of *Wolff*, *Hull* and *Bauer* can teach or suggest the invention as claimed in claims 8-13, 15, 16, 18, 23 and 27.

Claims 6, 7, 19-21 and 24-26 were rejected as being unpatentable over *Wolff* in view of *Hull* and further in view of U.S. Patent No. 6,317,777 issued to Skarbo, et al. (*Skarbo*). Claim 5 has been amended to depend from claim 3, which was indicated as allowable. *Skarbo* is cited to teach auto-deletion of an electronic document. Whether or not *Skarbo* discloses auto-deletion, *Skarbo* does not cure the deficiencies of *Wolff* and *Hull* as described above. Therefore, no combination of *Wolff*, *Hull* and *Skarbo* teaches or suggests the invention as claimed in claims 6, 7, 19-21 and 24-26.

Allowable Subject Matter

Claim 3 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including the limitations of the base claim. Claim 3 has been amended to include the limitations of the corresponding base claim (Claim 1). Claims 4 and 5 have been amended to depend from claim 3. Therefore, claims 3-5 are in condition for allowance.

Conclusion

For at least the foregoing reasons, Applicants submit that the rejections have been overcome. Therefore, claims 1 and 3-45 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application.

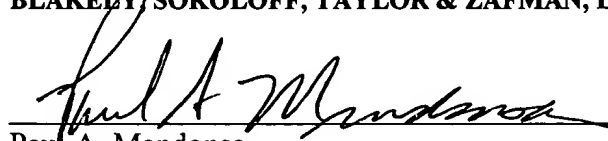
Application No. 09/398,229
Amendment dated October 17, 2005
Response to Office Action of June 17, 2005

Atty. Docket No. 74451.P100
Examiner Flynn, Kimberly D.
TC/A.U. 2153

Please charge any shortages and credit any overcharges to our Deposit Account number
02-2666.

Respectfully submitted,
BLAKELY SOKOLOFF, TAYLOR & ZAFMAN, LLP

Date: OCT 17, 2005


Paul A. Mendonsa
Attorney for Applicant
Reg. No. 42,879

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026
(503) 439-8778